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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,900

12/16/2005

Naoki Arai

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EXAMINER

EBRAHIM, NABILA G

ART UNIT

PAPER NUMBER

1618

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,900	Applicant(s) ARAI ET AL.	
	Examiner NABILA G. EBRAHIM	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Finality

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The receipt of amended list of claims and Applicant's remarks dated 04/28/2010 is acknowledged.

Status of claims:

Claims 1, 4-6 and 8-17 are pending in the application.

Rejections that are not reiterated in the current Office Action are hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 10-12, 15-17 rejected under 35 U.S.C. 102(b) as being anticipated by **JP 2794433 (abstract) published 09/03/1990 (JP '433)**. A full translation will be requested and provided for future communications during the current prosecution.

JP '433 teaches composition comprising a licorice-derived hydrophobic flavonoid (this ingredient contains the compounds recited in the claims and also the glycyrrhiza, evidence is provided in attached document EP 1491204) and middle chain fatty acid triglyceride including **caprylic acid triglyceride and capric acid triglyceride** or a mixture. Although instant claims did not limit the instant recited medium chain fatty acid, it is noted that the specification exemplified the fatty acid to constituent of about C8 to C10 fatty acids preferably at least about 50 wt% or more (see spec. page 12). It is noted that the viscosity recited in instant claim 1

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should be an inherent property to the medium chain fatty acid recited in the claims and exemplified by C8 to C10 fatty acid disclosed in the specification. The composition comprises (a) about 50 wt% or less licorice-derived hydrophobic flavonoid is directly added to middle-chain fatty acid triglyceride and stirred to obtain a uniform blend, or (b) licorice-derived hydrophobic flavonoid. The dose required in instant claim 4 is an inherent amount needed to improve the recited ailments. The composition is useful as antioxidant, bactericide, enzyme-inhibitor, colorant, tumoricide, anti-allergic agent and antiviral agent in the field of foods, cosmetics, medicines, agricultural materials. The middle-chain fatty acid triglyceride solubilizer makes the composition physically and chemically stable, and safe to use in foods (abstract). Regarding instant claim 17, JP '433 teaches that the composition improves allergy which is a life-style related disease. Note that Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case or either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-6, 8-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2794433 (JP '433) in view of Shinohara et al. US publication 20060247310 (Shinohara), the application was filed 03/03/2003.

JP '433 is relied upon for the reasons set forth hereinabove.

JP '433 did not teach the use of a partial glyceride in the composition.

Shinohara teaches body temperature elevating agents, foods and drinks for body temperature elevation (abstract and claims). The composition comprises medium chain triacylglycerol [0006, 0008, 0041, and claims 25, 30]. The carriers and the excipients used for these formulations include licorice among other ingredients [0065]. Shinohara also discloses that it is known that medium chain fatty acids are easy to be made into energy and thus accumulation of body fat is low and that it has been reported that the accumulation of body fat is

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low in a fat and oil composition comprising diacylglycerol and triacylglycerol and that [0006]. The composition comprises fats and oils [0046, 0096 and 0117]

Thus, it would have been obvious to a person having ordinary skill in the art at the time the current invention was made to include either or both diacylglycerol and triacylglycerol as disclosed by Shinohara into the food or drink disclosed by JP '433 because Shinohara discloses that it is known that medium chain fatty acids are easy to be made into energy and thus accumulation of body fat is low and that it has been reported that the accumulation of body fat is low in a fat and oil composition comprising diacylglycerol and triacylglycerol [0006].

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2794433 (JP '433) in view of PCT/JP01/10869 (WO 0247699). As a translation for the PCT, Mae et al. US 20040028751 will be used in the Office Action (Mae).

JP '433 is relied upon for the reasons set forth hereinabove.

JP '433 did not disclose the soft capsule required and the health problems recited in the claim 13 and 14.

Mae teaches a soft capsule containing licorice hydrophobic extract [0081] for ameliorating multiple risk factor syndrome involving visceral fat-type obesity, diabetes mellitus, hyperlipemia and hypertension. The capsule contains 40 wt% of the composition [abstract, example 2 and 0082]. The composition comprises fat and oil.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to prepare a soft capsule containing licorice hydrophobic extract since it was known that it was successfully made previously in the art and because soft capsules have an aesthetic appearance and are easy to swallow. The person having ordinary skill in the art would expect success in making a food or soft capsule containing Glycyrrhizae glabra extract to ameliorate different ailments.

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Response to Arguments

Applicant's arguments filed 12/20/2010 have been fully considered but they render moot in view of relying upon JP 2794433.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NABILA G. EBRAHIM whose telephone number is (571)272-8151. The examiner can normally be reached on Monday-Friday 10:00 AM -2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NABILA G EBRAHIM/
Examiner, Art Unit 1618

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit
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